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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,582	04/04/2002	Steve Vestergaard	119.5-US-WO	5988

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EXAMINER

TO, BAO TRAN N

ART UNIT PAPER NUMBER

2135

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/980,582	VESTERGAARD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bao Tran N. To	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/14/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This Office action responds to the applicant's Preliminary Amendment filed on 04/04/2002. Applicant amended Claims 1-13 and canceled Claims 14-16 in this amendment. Claims 1-13 are presented for examination.

#### ***Specification***

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Spies et al. (U.S. Patent 6055314) herein referred to as Spies.

Regarding on Claim 1, Spies discloses a method of distributing electronic media comprising the steps of: downloading a media file (a video program) including an

integral decryption engine (decryption capabilities) and encrypted media content (encrypted video data packets) (col. 3, lines 5-20 and 35-60).

requesting a decryption key (program key) from a remote server (video merchant) (col. 3, lines 45-50); and

responding to receipt of said decryption key from said remote server by:  
decrypting said media content using said integral decryption engine (col. 2, lines 55-60).

Regarding on Claim 2, Spies discloses the limitations as discussed in Claim 1 above. Spies further discloses viewing said media content by executing viewer software integral with said media file whereby a decrypted copy of said media content is not stored locally (col. 16, lines 50-55).

Regarding on Claim 3, Spies discloses the limitations as discussed in Claim 1 above. Spies further discloses viewing said media content by executing external viewer software linked to said media file, whereby a decrypted copy of said media content is not stored locally (col. 13, lines 2-10).

Regarding on Claim 4, Spies discloses a method of managing distribution of proprietary electronic media comprising the steps of: downloading a single file (a video program) executable to: decrypt an integral media file using an integral decryption engine (decryption capabilities) and a decryption key (program key) (col. 3, lines 5-20 and 35-60); and view said decrypted media file using an integral viewer (viewer

computing unit) (col. 10, lines 50-55).

Regarding on Claim 5, Spies discloses the limitations as discussed in Claim 4 above. Spies further discloses wherein said step of downloading comprises the step of: downloading said single file from a remote server via a communication network (col. 3, lines 10-20).

Regarding on Claim 6, Spies discloses the limitations as discussed in Claim 5 above. Spies further discloses downloading said decryption key from said remote server via said communication network (col. 3, lines 10-20).

Regarding on Claim 7, Spies discloses the limitations as discussed in Claim 6 above. Spies further discloses requesting a decryption key from a remote server (col. 3, lines 45-50); and said remote server responding to said request and responding to a digital wallet having sufficient funds, by returning said decryption key (col. 15, lines 60-67).

Regarding on Claim 8, Spies discloses the limitations as discussed in Claim 7 above. Spies further discloses bonding said media file to a computing device from which said request has initiated (col. 15, lines 30-35).

Regarding on Claim 10, Spies discloses the limitations as discussed in Claim 8 above. Spies further discloses wherein said step of bonding comprises the step of: communicating bonding information back to said remote server for storage (col. 15, lines 30-40).

Regarding on Claim 11, Spies discloses the limitations as discussed in Claim 5 above. Spies further discloses wherein said remote server tracks an originating Web site, enabling it to distribute revenues to rights holders (col. 5, lines 10-15).

Regarding on Claim 12, Spies discloses the limitations as discussed in Claim 2 above. Spies further discloses wherein said media file includes Web links to one or more of: artist, retailer, distributor and record label (col. 4, lines 55-60).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spies in view of Wiser et al. (U.S. Patent 6,385,596 B1) herein referred to as Wiser.

Regarding on Claim 9, Spies explicitly does not disclose a method of securely distributing media files comprising the steps of: generating an executable, encrypted media file which will execute to play only a portion of the corresponding original media file, without use of a decryption key.

However, Wiser clearly discloses the online music distribution system provides for previewing of audio data prior to purchase without using a decryption key (col. 3, lines 50-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Wiser's invention with Spies to provide for previewing of audio data prior to purchase without using a decryption key with the motivation to allow the consumer has the opportunity to watch the portion of the video program before ordering.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spies in view of Glover (U.S. Patent 6,052,780) herein referred to as Glover.

Regarding on Claim 13, Spies discloses a method of secure distribution of content over a communication network comprising the steps of: a Consumer (Purchaser) sending a request to an Internet Service Provider (ISP) (Video Content Provider) for a media file (a video program) (col. 3, lines 13-17); and said ISP returning said media file to said consumer (col. 9, lines 40-45).

Spies explicitly does not disclose said media file being wrapped in a single executable file including an integral decryption engine.

However, Glover clearly teaches said media file being wrapped in a single executable file including an integral decryption engine (col. 3, lines 45-50 and col. 20, lines 15-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Glover's invention with Spies to store the media file in the executable file which includes a decryption program with the motivation to allow to decrypt the encrypted data file.

### ***Prior Art***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jones et al. (U.S. Patent 6,697,944 B1) discloses a digital content file distribution, transmission, and protection system comprises a digital content provider having stored therein a digital content file such as an audio file, video file, literature, program file, etc.

Graunke et al. (U.S. Patent 5,991,399) discloses secure distribution of a private key to a user's application program (also called a "trusted player" such as a DVD player or DC-ROM player) with conditional access based on verification of the trusted player's integrity and authenticity is provided.



Brugger ( U.S. Patent 5,636,276) discloses in order to distribute music information from a central memory device via a communication network to a terminal, this information is organized in a digital music information object.

Challener et al. (U.S. Patent 6,311,270 B1) discloses a method is provided for communicating digital content between a content provider and a data processing system which is under the control a content consumer, utilizing an insecure communication channel.

Dimenstein (U.S. Patent 6,813,711 B1) discloses a method and apparatus for insuring that a digital storage device will only be able to download or play files that were obtained from sources deemed by the manufacturer of the device or by an overseeing organization to be acceptable.

#### ***Information Contact***

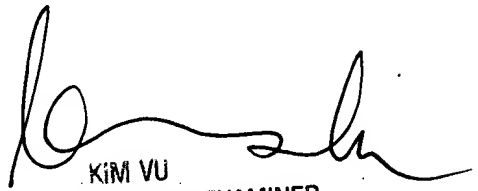
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao Tran N. To whose telephone number is 571-272-8156. The examiner can normally be reached on Monday-Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bao Tran N. To  
Patent Examiner  
08/01/2005



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